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EXAMINER

GARG, YOGESH C

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 07/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/442,106

Applicant(s)

PETTITT, JOHN PHILIP

Examiner

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 06 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 17-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10, 11, 12.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Response to Amendment***

1. Applicant's Response, paper number 13, received on 03/06/2003 are acknowledged and entered. Receipt of Terminal Disclaimer, paper # 14 is also acknowledged. No amendments have been made. Claims 17-30 are currently pending for examination.

***Terminal Disclaimer***

2. The terminal disclaimer, paper # 14, filed on 03/06/2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent Number 6,029,154 ( Application Number : 08/901,687) has been reviewed and is NOT accepted for the reasons given below.

The person who signed the terminal disclaimer is not recognized as an officer of the assignee, and he/she has not been established as being authorized to act on behalf of the assignee. See MPEP § 324.

***Response to Arguments***

3.1. With reference to the applicant's arguments filed on 03/06/2003 regarding double patenting rejection of claims 17-30 (see Response pages 2 under the heading "Rejections not based on Prior Art " ), the examiner does not agree as the applicant has not responded with any reasoning against rejection under double patenting and also the Terminal Disclaimer filed is improper as explained above. Therefore, rejection of claims 17-30 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,029,154 is maintained.

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3.2. Applicant's arguments with respect to prior art rejection regarding claims 17-30 have been considered but are not persuasive. With regards to the applicant's arguments that McCrea does not teach the subject matter of the claim and there is no suggestion to apply the teachings of McCrea in the field of fraud control, McCrea's teachings are non-analogous and that there is no obviousness or motivation to combine the teachings of McCrea with Wallace and Gopinathan (see Response, pages 2-7), the examiner does not agree for following reasons:

(i) In response to applicant's argument that McCrea is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, McCrea uses the Internet address to solve a problem of verifying the geographical location of an user of that Internet address which is analogous to the limitation recited in claim 1, that is, using the information of Internet address used by the consumer in his transactions to resolve the problem of verifying if the physical addresses used in association with that Internet address are consistent.

(ii) In response to applicant's argument that that there is no obviousness or motivation to combine the teachings of McCrea with Wallace and Gopinathan, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In response to applicant's arguments against the references individually, that is McCrea does not teach the feature of claim 17, cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA

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1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Here, the claim 17 has been rejected under 35 USC 103 (a) as unpatentable over Wallace/McCrea/Gopinathan. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

(iii) In response to applicant's argument that there is no suggestion to combine the references, "such a complex process as recited in Claim 17 should not stand rejected as obvious at the time of filing based on such a complicated, albeit crafty, combination of disparate references" (see response, page 4) and "In this case, reliance on three references for an obviousness rejection.....the rejection of Claim 17 is respectfully requested" (see response, page 5), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the teachings of Wallace and Gopinathan are in the same endeavor of verifying/analyzing fraudulent credit card transactions and have been combined with the teachings of McCrea to solve an analogous problem of using an Internet address to verify a correlation of the Internet address with a geographical address as stated in the earlier Office action. Also see *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991) which justifies

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reliance on a large number of references in a rejection as a large number of references do not weigh against the obviousness of the claimed invention. Also refer to the following court cases which justify the combining of Wallace/McCrea and Gopinathan to do what is being claimed in claim 17:

*In re Sheckler*, 168 USPQ 716 (CCPA 1971)

It is not necessary that a reference actually suggest changes or possible improvements which applicant made.

*In re Fine*, 5 USPQ2d 1596 (CA FC 1988)

The PTO can satisfy the burden under section 103 to establish a prima facie case of obviousness "by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references."

*In re Bozek*, 163 USPQ 545 (CCPA 1969)

"Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness 'from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.'"

*In re Gershon, Goldberg, and Neiditch*, 152 USPQ 602 (CCPA 1967)

"Although references do not disclose or suggest the existence of applicants' problem or its cause, claims are rejected under 35 U.S.C. 103 since references suggest a solution to problem; it is sufficient that references suggest doing what applicants did, although they do not teach or suggest exactly why this should be done, other than to obtain the expected superior beneficial results."

*In re Beattie*, 24 USPQ2d 1040 (CA FC 1992)

"Board of Patent Appeals and Interferences correctly held that it would be obvious to one having ordinary skill in art to combine prior art references in order to arrive at claimed marking system for reading and playing music on keyboard or stringed instruments, despite absence of single express teaching of marking system which combines two musical theories of prior art references, since law of obviousness does not require that references be combined for reasons contemplated by inventor, but only looks to whether some motivation or suggestion to combine references is provided by prior art taken as whole. "

(iv) With regards to the applicant's arguments regarding rejection of claim 21, "Applicant is not claiming the application of weighting factors to parameters, per se.....recite weighting each verification step according to importance determined by the merchant.....again appears that impermissible hindsight is being applied in the rejection of this claim ", the examiner does not agree. As demonstrated in the earlier Office action, the Official Notice consisted was directed to the old and well-known concept that teachers assign different weights-also corresponds to the importance- to quizzes, home assignments, class-work, and tests while evaluating the performance and to award a final and cumulative grade to the student renders the claimed limitation of claim 21 obvious. This is not a hindsight rejection as further justified by the court case: *In re McLaughlin*, 170 USPQ 209 (CCPA 1971) "Any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within level of ordinary skill at time claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, reconstruction is proper."

(v) With regards to the applicant's arguments regarding rejection of claim 27, the examiner observes that the applicant is arguing against the individual reference of Richardson instead of the combination of references Wallace/McCrea/Gopinathan/ Richardson used in the rejection of claim 27 in the earlier Office action. In response to applicant's arguments against the references individually, that is Richardson does not teach the feature of using a specific Internet address , cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Wallace/McCrea/Gopinathan/ teach use of Internet address in claim 24, as demonstrated in the earlier Office action and claim 27 is dependent on claim 24.

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In view of the foregoing, rejections of claims 17-30 are maintained.

This is a Final Office action.

***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper time wise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4.1. Claims 17-30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,029,154. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitation of "determining whether a physical address specified in the transaction information is consistent with other physical addresses.....with the Internet address of the consumer" in independent claims 17, 24, 28, 29 and 30 in the instant application is anticipated or an obvious variation of the claimed limitations "creating and storing a .....an Internet identification mechanism...based on transaction information, in combination with information that identifies the consumer, in which the transaction information provides the merchant..." And "obtaining other transactions utilizing an Internet address that is identified whether the credit card transaction". Since claims 18-23 and 25-27 are dependencies of claims 17 and 24 respectively they inherit their deficiencies and are rejected.



***Claim Rejections - 35 USC § 103***

Note: The prior art rejection of claims 17-30 are reproduced from the earlier Office action and are to be viewed in the light of "Response to Arguments" presented above.

5 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5.1. Claims 17--26, and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallace (US Patent 5,988,497) in view of McCrea et al., "The Internal Report" prepared by CSIRO for the Australian Taxation Office as part of the ATO's Electronic Commerce Project, June 1997, further in view of Gopinathan et al. (US Patent 5,819,226).

With regards to claims 17--26, and 28-30, Wallace teaches a method, system and a computer readable medium for detecting fraud in a transaction involving purchasing a product between a consumer and a merchant over the Internet (col.1, lines 5-40 and col.6, lines 6-17 ( "*transactions over a computer network, e.g., Internet*").

Wallace teaches receiving from the merchant or a number of merchants, credit card and transaction information (s) identifying the consumer (s) and product (s) and verifying various information based upon automatic verification system (it is inherent to check the name, address of the bearer presenting a credit-card for any purchase transaction involving shipping a package as admitted in the application on page 5, lines 15-18), consistency, and history checks verifying the credit card information that determines whether a physical address specified in the transaction information is consistent with other physical addresses that have been specified in a

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database of records (At least see col. 2, lines 4-15, "... *The necessity of a second tier of validation.....numerous threshold criteria or conditions.....transaction amount, credit limit, frequency of use....change in purchasing patterns(e.g., change in shipping address), geographical limitations, or the like....validation is justified*", col.4, lines 32-49, "...*For example, prevention of a fraudulent transaction....combination of threshold criteria (e.g., credit limit over \$5000....)....average charge is under \$100....trigger second tier validation*", and col.5, line 40-col.7, line 23. Note: Wallace here teaches carrying out validation check which corresponds to detection the fraudulent transactions on threshold criteria or numerous conditions covering history and consistency. Wallace uses this fraud detection procedure to determine whether to use further stringent methods to prevent fraudulent transactions but in no way teaches against the claimed invention in the application. ).

Wallace fails to teach use of an Internet address in the detection of fraud in a credit card transaction by verifying if the information about physical addresses associated with the internet addresses used in the transactions are consistent. However, McCrea teaches use of Internet addresses in verifying the physical address associated with the internet address (page 95-page 96, heading 3.2.2. 2 Identification at the IP level, "*IP numbers are the primary way of identifying computers engaged in Internet activities...IP numbers within Australia can be related to other legal entities.....*", page 112, 3.5.1.1 Identification Issues, "*....Most of the examples.....of tax compliance*", pages 159-161, C. Collecting information to assist with identification, "*..Recommendation 11....Webshop details ..include...IP number.....e-mail address for correspondence.....the computer containing the webshop.....the owner is an Australian resident.....Recommendation 14:...A record of the ranges of IP numbers of Australian based computers should be maintained....*". Note: Internet address detected in the Internet transactions is being used to verify if the physical address associated with the Internet address).

In view of McCrea it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Wallace to use Internet address in detecting the credit card fraud detection by verifying information about physical address associated with the Internet address used in the transaction. Doing so would provide an important parameter, another criteria, to detect the fraudulent credit-card transactions as suggested by Wallace (col.2, lines 4-15, *"....The necessity of a second tier of validation could be prompted by numerous threshold criteria of conditions. Examples of threshold criteria include transaction amount.....frequency of use, or the like, geographical limitations, or the like...These thresholds or conditions can be set by the service provider....."*). Note: Wallace keeps it open to determine the criteria to verify the credit card transaction for the second tier validation, if required and as suggested in McCrea, the criteria of verifying the consistency of the Internet address with a pre-defined physical address can be used.

Wallace/McCrea fails to teach creating and storing a fraud score value based on the verifying steps that provides the merchant with a quantifiable indication of whether the credit card transaction is fraudulent. However, Gopinathan, in the same field of endeavor, i.e., detection of credit card frauds discloses creating and storing a fraud score value based on the verifying steps that provides the merchant with a quantifiable indication of whether the credit card transaction is fraudulent (col.3, line 66-col.4, line 20, *"...Referring now also to FIGS.2.....System monitor 201 shows a cutoff score 202....the number of accounts with scores above the cutoff 203, and the fraud score 204.....FIG.3.....FIG.4..fraud score 403...."*). In view of Gopinathan, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Wallace/McCrea to include the feature of creating and storing a fraud score value based on the verifying steps that provides the merchant with a quantifiable indication of whether the credit card transaction is fraudulent. Doing so would help the

merchants to estimate a probability of fraud for each transaction, as suggested in Gopinathan (col.2, lines 27-34, "*.....In accordance.....there is provided...detecting fraudulent transactions.....to estimate the probability of fraud for each transaction*")

Wallace/McCrea/Gopinathan teaches that in neural networks the strength of parameters, in estimating probability of fraudulent credit card transactions, is represented by weights. However, Wallace/McCrea/Gopinathan does not teach that the weights are determined by merchants according to the importance of each verifying step in the credit card transaction. Official Notice is taken of both the concept and benefits to accord weights to various parameters, and weights being determined based upon the importance assigned to each parameter as per ones own discretion, to arrive at a final score/total to evaluate a performance. For example, it is well known that teachers assign different weights to quizzes, home assignments, class-work, and tests while evaluating the performance and to award a final and cumulative grade to the student. Therefore, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Wallace/McCrea/Gopinathan to include the feature of letting merchants determine the weights according to the importance of each verifying step. Doing so would help the merchants to represent the strengths of verifying steps, used in determining fraudulent credit card transactions, by weights as per their discretion, as suggested above in the example of teachers estimating the final grade of a student.

6. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wallace/McCrea/ Gopinathan and further in view of Richardson, R, "...Neural networks compared to statistical techniques ", Computational Intelligence for Financial Engineering (CIFEr), 1997., Proceedings of the IEEE/IAFE 1997, pages 85-89, 24-25 March 1997, New York City.

With regards to claim 27, Wallace/ McCrea/ Gopinathan teaches a method for detecting fraud in credit card transaction between a consumer and a merchant over the Internet as disclosed in claim 24 above. Wallace/ McCrea/ Gopinathan fails to teach constructing a map of credit card transactions and use of them. However, Richardson teaches constructing a map of credit card transactions and use of them (entire article. See Figures 2.3, 2.4, 2.5, 2.6 and 3.1. In view of Richardson, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to recognize the importance and benefits of constructing maps based upon transactions and using them and combine this feature with Wallace/ McCrea/ Gopinathan. Doing so would help to discriminate between normal account activity and fraudulent credit card transactions as suggested by Richardson (pg.90, under paragraph 2.3 Statistical Techniques, "... The process.....fraudulent transactions ").

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7.1. US Patent 5,970,469 to Scroggie et al. teaches a system and method for providing shopping aids and incentives to online customers (see at least abstract) and further teaches utilizing specifically Internet address to verify/validate the logging on of the users to correlate the Internet address with a particular geographic location (see col.6, line 53-col.7, line 14). Note: These teachings of Scroggie et al. when combined with Wallace/Gopinathan can render the limitations of claim 17 obvious.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

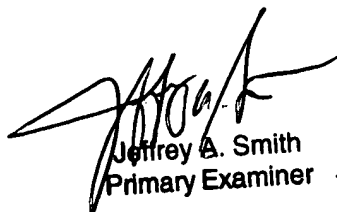
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Yogesh C Garg  
Examiner  
Art Unit 3625

YCG  
July 5, 2003

  
Jeffrey A. Smith  
Primary Examiner